

REMARKS

The Office Action dated December 15, 2003 has been carefully reviewed and the foregoing remarks are made in response thereto. In view of the above claim amendments and following remarks, Applicant respectfully requests reconsideration and reexamination of this application and timely allowance of the pending claims.

By this Amendment, claims 102 and 104 have been canceled and claims 122 and 123 have been amended. Applicant respectfully submits that the amended claims 122 and 123 fall within the subject matter of the elected invention because they are directed to methods for determining a BRCA1 haplotype using a nucleic acid sequence comprising SEQ ID NO: 263 and the protein encoded by this nucleic acid (SEQ ID NO: 264), just as in claim 97 and 115. Applicants further submit that no new prohibited matter has been introduced by the amendments.

Summary of the Office Action

1. The previous amendment filed by Applicants on September 17, 2003 was purported by the Examiner to be non-responsive.
2. The substitute claims were restricted into two groups by the Examiner, claims 97 to 121 into Group I and claims 122 to 124 into Group II.
3. A further restriction was set forth in the claims 102 and 104 in Group I requiring election of a single oligonucleotide among SEQ ID NO: 171 to 192.

Response to Restriction Requirement

In response to the restriction requirement set forth in the Office Action date December 15, 2003 Applicants hereby elect the claims in Group I with traverse. Applicants bring to the attention of the Examiner that the claims 122 to 124 have been amended so that they are now directed to the subject matter of the claims in Group I (SEQ ID NO: 263 and 264). Applicants therefore request rejoinder of claims 122 to 124 with the claims in Group I.

With regard to the traversal, Applicants submit that the Examiner has improperly restricted claims 102 and 104. In order to properly set forth a restriction with regard to the claimed method using the oligonulceotides recited in dependent claims 102 and 104, the Examiner must give an example of an alternative use for any one of the oligonucleotides recited in these claims (see MPEP 806.04(b)) in order to establish that they are distinct. The Examiner has not provided any such alternative use and has instead

treated these claims as being directed to the oligonucleotides themselves and not the methods of use as embodied in the claims. These dependent claims merely recite oligonucleotides that can be used to practice the method of claim 97 and as such should be treated as species of the claimed method.

Furthermore, Applicants bring to the attention of the Examiner that the oligonucleotides in claims 102 and 104 are amplification primers, and as such are used in pairs. Thus, restriction to a single oligonucleotide would also be improper because multiple primers are required from Table 9 to practice any single embodiment of the claimed invention. Applicants therefore reserve the right to add new claims directed to the subject matter of claims 102 and 104 upon allowance of claim 97.

Conclusion

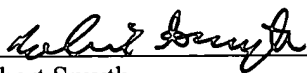
The foregoing remarks are being made to place the application in condition for allowance. Applicant respectfully requests reconsideration and timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, she is invited to telephone the undersigned at her convenience.

If there are any fees due in connection with the filing of this amendment, please charge the fees to our Deposit Account No. 50-310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **constructive petition for extension of time** in accordance with 37 C.F.R. 1.136(a)(3).

Dated: **January 15, 2003**
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Respectfully submitted
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